

## REMARKS

This Amendment is submitted in response to the Examiner's Action dated September 16, 1999.

In the Office Action, the Examiner objected to and rejected the claims for a number of reasons, including the following:

(1) The Examiner objected to Claims 1, 3, 4, and 8 for reasons related to matters of form.

(2) The Examiner rejected Claims 1, 3, 4 and 7 under 35 USC Section 102 as being anticipated by Yamada et al., USPN 5,063,508 which is hereinafter referred to as the '508 Yamada et al. patent.

(3) The Examiner rejected Claim 2 under 35 USC Section 103 as being obvious in view of the '508 Yamada et al. patent.

(4) The Examiner rejected Claims 5 and 6 under 35 USC Section 103 as being obvious in view of the '508 Yamada et al. patent and Tanimoto et al., USPN 4,658,374, and Kumar USPN 5,648,760.

(5) The Examiner rejected Claims 8-10 under 35 USC Section 103 as being obvious in view of the '508 Yamada et al. patent, Tanimoto et al., Maruta et al., USPN 5,523,943, and Kumar.

(6) The Examiner rejected Claims 12, 13, 14, 15, and 17 under 35 USC Section 103 as being obvious in view of the '508 Yamada et al. patent and Kumar.

(7) The Examiner rejected Claim 16 under 35 USC Section 103 as being obvious in view of the '508 Yamada et al. patent and Charlton USPN 5,929,774.

Applicant has addressed all matters of form raised by the Examiner. Applicant traverses the Examiner's rejection of the claims based upon the prior art references and submits the following evidence and arguments in support of patentability of the amended claims.

Applicant will proceed by providing a brief overview of the applicable law. Then, the scope and content of the prior art references relied upon by the Examiner will be reviewed. Finally, the difference between the amended claims and the prior art references will be discussed.

### **THE LEGAL STANDARD FOR REJECTIONS UNDER 35 USC § 103**

The following provides an overview of the applicable legal standards for determining "obviousness":

(1) **WHAT IS EXAMINED:** 35 U.S.C. §103 mandates that the invention "as a whole" be considered in making an obviousness determination, and reads as follows:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

(2) **THE OBVIOUSNESS TEST:** In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court set forth the basic test for determining if an invention is obvious, stating at 383 U.S. 17-18:

"...the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined."

(3) **TIME FRAME OF THE ANALYSIS:** 35 U.S.C. §103 mandates that the analysis be performed "at the time the invention was made".

(4) **THE BURDENS:** The USPTO bears the burden of establishing a *prima facie* case of obviousness, as is adequately summarized in *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) which reads in relevant part, at 972 F.2d 1783, 1784:

"In proceedings before the Patent and Trademark office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art . . . . [The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The patent applicant may then attack the Examiner's *prima facie* determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness."

What is required to meet this burden and establish a *prima facie* case of "obviousness" is quite particular, as explained in *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), at 837 F.2d at 1598, 1599, 1600, with emphasis supplied:

"The PTO has the burden under section 103 to establish a *prima facie* case of obviousness . . . . It can satisfy this burden only by showing some **objective** teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teaching of the references."

(5) **THE REQUIREMENT OF A WRITTEN EXPLANATION:** 35 U.S.C.

§132 provides the standards for a written explanation of a rejection, stating in relevant part:

"Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging the propriety of continuing the prosecution of his application; . . . ."

(6) **THE STANDARD OF REVIEW ON APPEAL:** It is well established that an obviousness determination is a question of law which is freely reviewable on appeal; in other words, the obviousness determination made by the USPTO is reviewed by the court *de novo*, while the factual findings underlying the obviousness determination are reviewed for "clear error". See *In re Woodruff*, 919 F.2d 1575, 1577, 16 USPQ2d 1934, 1935 (Fed. Cir. 1990).

(7) **IMPERMISSIBLE ACTIVITIES:** A substantial body of law exists which constrains the USPTO to proper considerations in performing an obviousness analysis. A few particular constraints are pertinent in the present prosecution and will now be discussed.

First, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion that the combination be made. See *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1061 (Fed. Cir. 1987).

Second, the mere fact that the prior art could be modified as suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. See *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

Third, before the USPTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, these must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Fourth, there must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination, and that knowledge cannot come from the appellant's invention itself. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Fifth, it is impermissible for the USPTO to simply engage in hindsight reconstruction of the claimed invention, using the applicant's invention as a template and selecting elements from the references to fill the gaps. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

## **THE SCOPE AND CONTENT OF THE PRIOR ART REFERENCES**

### **SCOPE AND CONTENT OF THE YAMADA ET AL. REFERENCE**

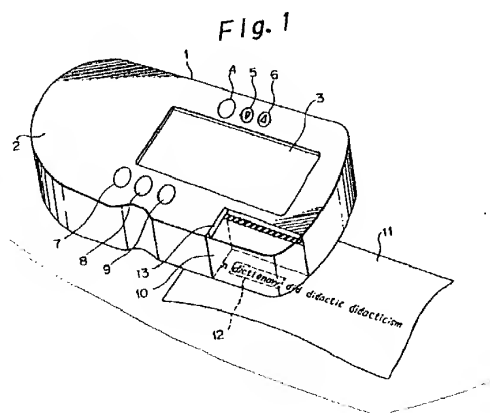
The '508 Yamada et al patent is directed to the device which may be utilized as an electronic dictionary which is capable of translating a word in a source language to an equivalent word in a target language.

Applicant would like to make several initial observations about the '508 Yamada et al patent, including the following specific observations:

- The device of Yamada, et al has a relatively large rectangular housing with a shape which is not unlike that of a brick generally;
- The device is designed to lie flat on the page;
- The device covers a large portion of text on the page;
- The device is stationary during scanning, and is not moved or "wanded" across the words on the page;
- The scanning device and the display are oriented in parallel planes.

Each of these observations will be discussed with specific reference to the specification and drawings of the '508 Yamada et al patent.

**ENLARGED HOUSING:** The device described and depicted in the '508 Yamada et al patent is a relatively large device. This is clearly shown in the figures, and in particular, in Figure 1 which depicts the electronic dictionary 1 oriented relative to document 11, with a particular word oriented in the read frame 12 of the electronic dictionary 1. As is shown, the device is relatively large in comparison to the words that are being scanned by the device. It is clear the device of electronic dictionary 1 will cover a significant portion of the page.



Just by examining Figure 1, it is clear that the (left to right) size of the device is at least five times the size of the word "dictionary" in the read frame 12. Again,

just by examining Figure 1, it is clear that the top to bottom size of the electronic dictionary 1 is sufficient to cover numerous lines of text, possibly greater than five or six lines of text. Additionally, and again just by examining Figure 1, it is clear that the height of the electronic dictionary 1 is likely equal to or greater than the size of one or two words.

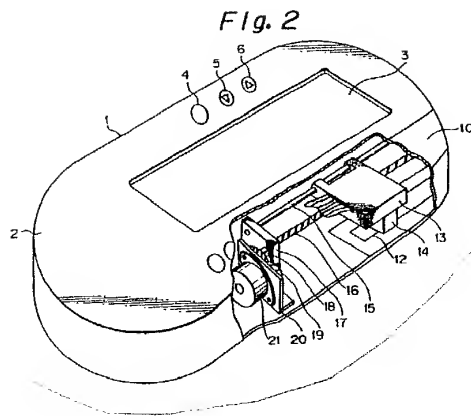
LARGE PORTION OF TEXT COVERED: The electronic dictionary 1 of the '508 Yamada et al patent is so large that it completely covers and obscures a significant portion of the text. It is clear from the view of Figure 1 that it lies flat on the page. In fact, in partial compensation for this covering, some of the case is formed from transparent plates to allow the operate to view a small portion of the document through the device. This is clear from the specification commencing at Column 3, Line 12, which reads in relevant part as follows:

"The upper side, lower side, front side and right side of the read unit 10 are defined by transparent plates to enable an operator to view a document 11 placed under the lower side from a position above the read unit 10, or from an upper-right hand position with respect to the read unit 10."

It is very clear that the device is placed in direct contact with the document. Applicant directs the Examiner's attention to Column 3, commencing at Line 18 with reads in relevant part as follows, with emphasis supplied:

"In use, the electronic dictionary **is placed on a document** so that the read unit 10 is located on an objective word."

THE DEVICE IS STATIONARY DURING USE: It is also clear from the specification that the device of the '508 Yamada et al patent is entirely stationary during use. Figure 2 depicts a photoelectronic scanning head moving mechanism which is provided within the device. Figure 2 is reproduced below for the Examiner's convenience.



The specification makes it clear that a relatively complicated mechanism is provided within the electronic dictionary 1 of the '508 Yamada et al patent in order to move a scanning head across a line of text. A motor is provided to rotate a screw rod through gears in order to advance a carriage across a guide shaft. Applicant directs the Examiner's attention to the specification, commencing at Column 3, Line 28, which reads in relevant part as follows:

"Fig. 2 shows a photoelectric scanning head moving mechanism provided within the read unit 10. A photoelectric scanning head 14 is attached to the carriage 13 so as to face downward. The carriage is supported on a guideshaft 15 for sliding movement along the guideshaft 15. The carriage 13 is moved by a screw rod 16 extending parallel to the guide shaft 15. The screw rod 16 is provided externally of the screw thread. The lower part of the carriage 13 engages a screw thread of the screw rod 16. The screw rod 16 is rotated to move the carriage 13. The guideshaft 15 is fastened at its opposite side to a side plate 17 and another side plate, not shown. The screw rod 16 is journaled on the two side plates, and a gear 18 is fixed to one end of the screw rod. The gear 18 is engaged with the gear 19 fixed to a gear rotor shaft of a pulse motor 21 held on a plate 20. When the pulse motor 21 operates, the screw rod 16 is rotated through the gears 18 and 19 by the pulse motor 21. The carriage 13 advances to the right when the rotor shaft of the pulse motor 21 rotates in one direction, and to the left when the same rotates in the opposite direction. As the carriage 13 is moved within the read unit 10, the photoelectric scanning head 14 scans the space within the read frame 12."

The fact that the device is laid flat on the document and stationary during use is set forth in clear terms in Column 2, commencing at Line 26, which reads in relevant part as follows:

"In using the electronic dictionary of the present invention, the electronic dictionary is placed on a document with the read unit located on an objective word, and then the push button of the start switch is depressed. Consequently, the carriage moves within the read unit, and the photoelectric scanning head scans the objective word for reading."

It is clear that there is no wandering motion whatsoever made by the operator.

DISPLAY IN SAME PLANE AS DOCUMENT: It is clear from the foregoing that the display 3 of the electronic dictionary 1 of the '508 Yamada, et al patent is in a plane parallel to the plane of the document 11.

#### **SCOPE AND CONTENT OF THE TANIMOTO ET AL. REFERENCE**

The Examiner relies upon Tanimoto et al as teaching the use of a detachable keyboard. Tanimoto is an organizer-style language interpreter. While a keyboard is present, none of the other elements of claim 1 are present in this device.

#### **SCOPE AND CONTENT OF THE MARUTA REFERENCE**

The Examiner relies upon the Maruta reference as teaching the use of an audio output device. Maruta is a handheld translation device. It does not teach any of the elements of claim 1.

#### **SCOPE AND CONTENT OF THE KUMAR REFERENCE**



The Examiner relies upon the Kumar reference as teaching the use of a microphone input and the generation of text as an output. Kumar is directed to a portable messaging and scheduling device. It does not teach any element of independent claim 1.

#### **SCOPE AND CONTENT OF THE CHARLTON REFERENCE**

The Examiner relies upon Charleton as teaching the inclusion of a pager function. Chareton is directed to a combination pager, organizer, and radio. This reference does not teach any of the elements of claim 1.

#### **DIFFERENCES BETWEEN THE CLAIMS AND THE PRIOR ART**

As amended independent claim is patentably distinct over the prior art.

Claim 1 specifically requires the inclusion of an elongated housing. The primary and secondary references relied upon by the examiner teach rectangular housings. This is especially true for the Yamada et al patent. Thus Yamada et al teaches away from the present invention.

Claim 1 requires location of a scanning input at a tapered distal end of the elongated housing. This is also not taught by the primary and secondary references, especially for the Yamada et al reference. Yamada et al teaches the location of the scanning input in a corner portion of the generally brick-shaped casing, thus teaching away from the present invention.

Claim 1 specifically requires the wandling motion of the scanner input to scan in text. The references relied upon by the examiner do not teach this. The Yamada et al reference teaches a stationary device which has moving internal parts, thus teaching away from the present invention.

Claim 1 teaches the scanning of text with the scanning input in contact with the surface which carries the text, and with the elongated housing held in the user's hand, and with the elongated housing oriented generally transverse to the surface which carries the text.

Yamada et al teaches away from this since the device is not held in the user's hand during use, but is instead layed flat on the surface which carries the text. In Yamada et al the device is not moved, but instead uses internal moving parts to scan in the text. Also the housing of Yamada et al is parallel to the surface of the text, and is not oriented generally

transverse to the surface as required by claim 1. Thus Yamada et al teaches away from the present invention.

Claim 1 requires the display to be carried in general alignment with the longitudinal axis of the housing. In contrast the Yamada et al reference teaches the location of the display in a parallel orientation to the surface which carries the text, again teaching away from the present invention.

Claim 1 requires the location of the output text in an alignment with the longitudinal axis of the housing with the left-most portion of the output text more proximate the scanning input. This allows the present invention to be read while held.

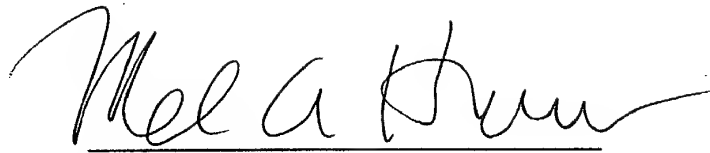
The features of claim 1 render the present invention more easily used than the prior art devices. It can be held and used in one hand. The use of the present invention does not block the view of the text. The present invention does not require the reader to be seated at a table in order to use the device.

For the stated reasons the present invention as presently claimed is patentably distinct over the prior art.

A request for a three-month extension of time and a check in the amount of \$435.00 is enclosed herewith. If any additional fees are required please charge that fee to Deposit Account No. 06-0580.

A handwritten signature in black ink, consisting of a stylized, cursive letter 'A' followed by a horizontal line extending to the right.

Respectfully submitted,

A handwritten signature in cursive script, reading "Melvin A. Hunn". The signature is written in dark ink and is positioned above a horizontal line.

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**ATTORNEY FOR APPLICANT**

A handwritten lowercase letter 'a' in cursive script, located in the bottom right corner of the page.